

**REMARKS**

Claims 1-20 were pending in this application.

Claims 1-20 have been rejected in this application.

Claims 1, 7, 8, and 17 have been amended as shown above.

Claims 1-20 remain in this application.

Reconsideration of the claims is respectfully requested.

**Drawing Requirement**

In response to the approval of the proposed drawing correction filed on March 12, 2002, the Applicants are submitting formal drawings under separate cover.

**35 U.S.C. § 103(a) – Obviousness**

Claims 1, 3-7, and 17-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,085,085 by Blakeney, II et al. ("*Blakeney*") in view of U.S. Patent No. 6,021,328 by Curtis et al. ("*Curtis*") and U.S. Patent No. 6,188,897 by Nelson ("*Nelson*"). Claim 2 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Blakeney*, *Curtis*, and *Nelson* in view of U.S. Patent No. 5,548,818 by Sawyer et al. ("*Sawyer*"). Claims 8-10 and 14-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sawyer* in view of *Curtis* and *Nelson*. Claims 11-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sawyer*, *Curtis*, and *Nelson* in view of *Blakeney*. These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and

the reasonable expectation of success must both be found in the prior art, and not based on the applicant's disclosure. MPEP § 2142.

None of the cited references disclose, teach, or suggest determining an error rate associated with messages received over a control channel both when a mobile station is in an idle state and when the mobile station is in an active state. Regarding *Blakeney* and *Sawyer*, the Office Action acknowledges that both references fail to disclose determining an error rate of any messages. (*Office Action, Page 2, Last paragraph - Page 3, First paragraph; Page 7, Second paragraph*). Because both references fail to disclose determining an error rate of messages, both references also fail to disclose, teach, or suggest determining an error rate of messages when a mobile station is in an idle state and when the mobile station is in an active state.

Regarding *Curtis*, the Office Action acknowledges that *Curtis* fails to disclose receiving messages over a control channel. (*Office Action, Page 3, Last paragraph*). Not only that, *Curtis* determines whether to initiate a handoff of an actual call based on the quality of a traffic channel used by that call. (*Col. 3, Lines 39-59*). There is no disclosure, teaching, or suggestion in *Curtis* that the quality of the traffic channel is monitored both when a mobile station is in an idle state and when the mobile station is in an active state.

*Nelson* recites a system that monitors the quality of a control channel and prevents roaming when a mobile station is in a coverage hole that is not near the periphery of the coverage area. (*Col. 5, Lines 6-29 and 63-66*). *Nelson* lacks any disclosure, teaching, or suggestion that the control

channel is monitored both when a mobile station is in an idle state and when the mobile station is in an active state.

As a result, the cited references fail to disclose, teach, or suggest determining an "error rate when the mobile station is in an idle state and when the mobile station is in an active state and receiving service" as recited in Claims 1, 8, and 17.

For these reasons, the Office Action fails to establish a *prima facie* case of obviousness regarding Claims 1, 8, and 17 (and their dependent claims). Accordingly, the Applicants respectfully request withdrawal of the § 103(a) rejection of Claims 1-20.

SUMMARY

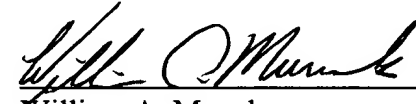
For the reasons given above, the Applicants respectfully request reconsideration and allowance of pending claims and that this application be passed to issue. If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

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